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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/955,815

Applicant(s)

SESEK, ROBERT

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/19/01;4/28/03</u>   | 6) <input type="checkbox"/> Other: _____                                    |

1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 is acknowledged.

2. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the application data in paragraph number 2 on page 1, "[0002] Metered mail is ... parcel, described in U.S. Patent Application No. 09/150,487 filed September 9, 1998, a printing ... the weight of a parcel in postage computing systems.";

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, --which is expired--, etc.

B) the following errors have been noted in the specification:

(1) at line 5 of paragraph number 16 on pages 4-5, "tocompute" should be -to compute--, see below:

[0016] An optional scanner 40 or other measuring device may be used to detect the planar size of the parcel. The scanner detects the planar size of the envelope and, inferentially, the planar size of the media contained in the envelope. If the size of the envelope and media is detected with scanner 40, it is not necessary for the computer to know this size information in advance [[tocompute]] to compute weight and, therefore, postage from the thickness measurement. In the law firm example described above, the user need only key in a run of 20# bond tri-fold sheets. The scanner will detect the Standard No. 1 size envelope and the A4 size paper.

Appropriate correction is required.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

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4. Claims 1-10 & 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 In regard to claims 1, 4-5, 7, 9, 10 & 15, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 1, and:

(1) how the “weight data for the print medium” may be accessed, since the invention as recited in this claim does not identify the print medium; and

(2) how the “weight of the parcel” may be computed, since the invention as recited in this claim does not identify the print medium or the packaging/envelope or the quantity of the contents of the packaging/envelope all of which would contribute to the final weight of the parcel.

B) in regard to claim 6, and:

(1) why the “weight data for different types of print media” are accessed, since the invention as recited in this claim does not use this information and does not identify a particular type print medium; and

(2) how the “weight of the parcel” may be computed, since the invention as recited in this claim does not identify the print medium or the packaging/envelope or the quantity of the contents of the packaging/envelope all of which would contribute to the final weight of the parcel.

C) in regard to claim 7 and:

(1) how the “weight data for different types of binders” is accessed, since the invention as recited in this claim does not identify a particular type of binder; and

(2) why is “at least one type of binder” detected, since the invention as recited in this claim does not identify the binder or the print medium or the packaging/envelope or the quantity of the contents of the packaging/envelope all of which would contribute to the final weight of the parcel.

D) in regard to claim 9, and:

(1) why the “size” of a “parcel” is detected, since the invention as recited in this claim does not use this information; and

(2) how the “weight of the parcel” may be computed, since the invention as recited in this claim does not identify the print medium or the packaging/envelope or the quantity of the contents of the packaging/envelope all of which would contribute to the final weight of the parcel.

E) in regard to claim 10, and:

(1) why the “weight data for different types of print media and different types of envelopes” are accessed, since the invention as recited in this claim does not use this information and does not identify a particular type print media or envelope; and

(2) how the “weight of the parcel” may be computed, since the invention as recited in this claim does not identify the print medium or the packaging/envelope or the quantity of the contents of the packaging/envelope all of which would contribute to the final weight of the parcel.

F) in regard to claim 15, and:

(1) why the “weight data for different types of print media and different types of envelopes” are accessed, since the invention as recited in this claim does not use this information and does not identify a particular type print media or envelope; and

(2) how the “weight of the parcel” may be computed, since the invention as recited in this claim does not identify the print medium or the packaging/envelope or the quantity of the contents of the packaging/envelope all of which would contribute to the final weight of the parcel.

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4.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

5. Claim 12 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

5.1 Since claim 12 appears in all respects to be a copy of claim 11, claim 12 fails to further limit the subject matter recited as the invention of claim 11.

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6.1 Claim 15 is rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

6.1.1 The instant claims recite a system/device/manufacture, (claim 15), which has a disclosed practical application in the technological or useful arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device/manufacture that contains a data structure comprising series of steps or acts or functions or operations that as claimed could be but are not necessarily to be performed by a computer.

6.1.2 It is further noted that applicant has not recited a specific machine since the steps or acts or functions or operations recited in the claim are merely to illustrate the steps or acts or functions or operations of the instant invention since these steps or acts or functions or operations as claimed are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claim 15 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way, as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory device alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

6.1.3 In view of the above, the invention recited in claim 15, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claim 15 does not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

6.1.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium;
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

6.1.5 Hence, claim 15 is directed to non-statutory subject matter.

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6.2 Claims 1-10 & 15 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

6.2.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Cons. Art. 1, sec. 8.”, {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 “14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.”;



and “Concerning claims 14-39 and the significance of “post-solution activity,” like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.”, {emphasis added}.

6.2.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the “specified adjusted location” in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process with in the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non statutory subject matter.

6.2.3 As can be seen from claims 1-10 & 15, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 1-10 & 15 under 35 U.S.C. § 112 2<sup>nd</sup> paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process with in the meaning of machine or process as used in 35 U.S.C. § 101.

6.2.4 Further on regard to the computer useable/readable medium of claim 15, the recited limitations are not clearly and definitely interconnected to one another and a device to execute the program code/instructions on the media so as to provide a useful operative and useful manufacture with in the meaning of machine or process as used in 35 U.S.C. § 101.

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.1 Claims 1, 5, 6, 8-10 & 15 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Vogel (5,914,464).

7.1.1 In regard to claims 1, 5, 6, 8-10 & 15, Vogel ('464) in the environment of computer implemented and controlled postage metering systems that under the control of code/instructions stored in memory provide a postage metering system. The system of Vogel ('464) determines the weight and size of an item, where the size includes a thickness determination, in order to access postal rates stored in relation to the size and weight so as to determine the correct postage for the item. Once the correct postage for the item has been calculated/determined, then a postage indicia is applied to the item.

8. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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8.1 Claims 2-4, 7 & 11-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Vogel (5,914,464) as applied above to claims 1, 5, 6, 8-10 & 15, and further in view of Kara (5,822,739).

8.1.1 In regard to claims 2-4, 7 & 11-14, Vogel ('464) does not disclose that the accessing of weight data involves using the weight/thickness of the print medium (claims 2 & 11-14), how the print medium is folded (claim 3) and if metal is detected (claims 4, 7 & 13), however, as taught by Kara ('739) the weight of an item mail may be obtained from knowledge about the contents of the item of mail, for example, the size and thickness of the paper, number of sheets and if any other material for binding is contained within the item of mail, since each of these features of the item of mail would affect the final weight of the item of mail.

8.1.2 Since one of ordinary skill at the time of the invention would have recognized that the correct postage for an item of mail is related to the weight of the item of mail and that the weight of the item of mail is dependent on the contents of the item of mail, it would have been obvious to one of ordinary skill at the time of the invention that the weight determination of Vogel ('464) could be based on knowledge about the contents of the item of mail and the associated weight values for each of the contents of the item of mail as taught by Kara ('739).

9. The examiner has cited prior art of interest, for example:

A) Kolisch (2,689,082) or Sakai et al (5,121,328) or Uno et al (5,535,127) Conte (DE 19711160) or the Computing Canada article disclose that the shipping fee for an item is based on the weight of the item and the size/dimensions of the item, for example, length, width, and height/thickness.

B) Baggarly et al (4,639,873) which disclose that the weight of an item of mail may be estimated based on the per unit weight of the contents and the number of contents and then the estimated weight is used to determine the correct associated postage for the item of mail.

10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

11.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

11.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/14/05



Edward R. Cosimano  
Primary Examiner A.U. 3629